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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/520,952	01/10/2006	Matthias Hauser	J&J2126USPCT	4882
27777 7590 09/28/2009 PHILIP S. JOHNSON JOHNSON & JOHNSON ONE JOHNSON & JOHNSON PLAZA NEW BRUNSWICK, NJ 08933-7003				
EXAMINER LOVE, TREVOR M				
ART UNIT		PAPER NUMBER		
1611				
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09/28/2009		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/520,952

**Applicant(s)**

HAUSER ET AL.

**Examiner**

TREVOR M. LOVE

**Art Unit**

1611

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 08 September 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1, 3, 6, 7, 10-12, 15, 16, 23, 25-33 and 35 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 3, 6, 7, 10-12, 15, 16, 23, 25-33 and 35 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

Acknowledgement is made to Applicant's request for continued examination filed 09/08/2009.

Claims 1, 3, 6, 7, 10-12, 14-16, 23, 25-33, and 35 are pending and currently under consideration.

The claim objections of record are withdrawn in view of Applicant's amendments to claims 1 and 6.

The rejection under 112 second paragraph is withdrawn in view of Applicant's amendments to claim 1.

The rejection under 35 U.S.C. 102(b) is withdrawn in view of Applicant's amendments. However, in view of Applicant's amendments, further search and consideration has been conducted and a new ground of rejection has been set forth below.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

**Claims 1, 3, 6, 7, 10-12, 14-16, 23, 25-33, and 35 are rejected under 35 U.S.C. 103(a) as being unpatentable over McAtee et al (U.S. Patent 6,153,208).**

With regard to **instant claim 1**, McAtee teaches a substantially dry, disposable, personal cleansing article useful for both cleansing the skin or hair (see abstract). There is no indication in McAtee that said applicator must be a porous or absorbent sheet. Said cleansing article comprises a substrate, a surfactant phase, and a lipid phase (see examples 1-5). Said lipid phase comprises hardening materials. Said hardening materials are selected from fatty acid esters such as mono-, di-, or

triglycerides (see column 32, lines 21 and 49-50), animal based fats and oils and vegetable oils, such as **hydrogenated castor oil** or **hydrogenated rapeseed oil** (see column 32, lines 21, 58, and 67, and column 33, lines 3-4), fatty acids having from about 10 to 40 carbon atoms, such as triglycerides or diglycerides (see column 32, lines 22-23 and column 33, lines 47-48), fatty alcohols such as **cetyl alcohol** and **behenyl alcohol** (see column 32, lines 20, 34-48, and claim 10), alpha-hydroxy fatty acids and fatty acids having from about 10 to about 40 carbon atoms, such as **behenic**, **euric**, **stearic**, and **lauric** acids (see column 32, line 22 and column 33, lines 12-16), and esters of fatty alcohols, such as the C18 hydroxy fatty alcohol **di-12-hydroxystearate** (see column 32, lines 45-46) and **mixtures thereof** (see column 32, line 25). McAtee also teaches that suitable emulsifiers in the lipid phase have an HLB value of between 1 and 7 (see column 30, lines 11-20). Said emulsifiers being present in an amount of 3-6% (see column 30, lines 8-11). Said hardening components are taught as being present in the McAtee in a range of about 0.1% to about 99.9%, and more preferably about 2% to about 25% of the conditioning component (see column 32, lines 1-7). In one of the preferred embodiments of McAtee, the lipid phase comprises at least two components that could be considered active agents, specifically, vitamin E acetate and tribehenin (see column 52, lines 36-38). Said hardening materials have a melting point between 30° and 250° C, and more preferably between about 37° and about 80° C (see column 32, lines 8-12). McAtee teaches that the lipid phase is present in an amount ranging from 0.10 to 0.35 weight percent (see examples 1-5, table bridging column 52 and 53). With regard to the limitation in instant claim 1 that requires the aqueous phase

to be present in an amount from about 1 to about 10 grams per 1 gram substrate, McAtee teaches that the surfactant in the aqueous phase is present as 0.5 to 12.5% of the substrate (see column 18, lines 24-28), wherein it is further taught that said surfactants are present as approximately 13% of said aqueous phase (see examples 1-5, table bridging column 52 and 53). Therefore, said aqueous phase is in a ratio of about 1:1 with the substrate. Said aqueous phase further comprises a lathering surfactant with an HLB value of above 10 (see column 18, lines 41-43). Said lathering surfactant is taught as being present in an amount of most preferably 1-10% (see column 18, lines 25-28).

With regard to the dependent claims, McAtee teaches that said hardening materials have a melting point between 30° and 250° C, and more preferably between about 37° and about 80° C (see column 32, lines 8-12), this reads on **instant claim 3**. Said hardening materials are selected from fatty acid esters such as mono-, di-, or triglycerides (see column 32, lines 21 and 49-50), animal based fats and oils and vegetable oils, such as hydrogenated castor oil or hydrogenated rapeseed oil (see column 32, lines 21, 58, and 67, and column 33, lines 3-4), fatty acids having from about 10 to 40 carbon atoms, such as triglycerides or diglycerides (see column 32, lines 22-23 and column 33, lines 47-48), fatty alcohols such as cetyl alcohol and behenyl alcohol (see column 32, lines 20, 34-48, and claim 10), and alpha-hydroxy fatty acids and fatty acids having from about 10 to about 40 carbon atoms, such as behenic, euric, stearic, and lauric acids (see column 32, line 22 and column 33, lines 12-16), these read on **instant claims 6, 7, 10-11, 13-15** respectively. Said hardening components are

taught as being present in the McAtee in a range of about 0.1% to about 99.9%, and more preferably about 2% to about 25% of the conditioning component (see column 32, lines 1-7), this reads on **instant claims 12 and 16**. McAtee also teaches that the lipid phase can comprise 10% petrolatum, 5% tribehenin, 2% vitamin E acetate, 3% synthetic beeswax, 9% polyethylene wax, and 0% water (see column 53, lines 33-42). Furthermore, component (a) can alternatively be a C8-C30 dialkyl ether (see column 25, line 47 through column 26, line 5, particularly noting petrolatum in line 58, and di C8-C30 alkyl ether in line 5). In one of the preferred embodiments of McAtee, the lipid phase comprises at least two components that could be considered active agents, specifically, vitamin E acetate and tribehenin (see column 52, lines 36-38). McAtee also teaches that the active can be a sunscreen (see column 47, line 26 through 65), this reads on **instant claim 26**. Furthermore, vitamin E acetate, also known as tocopheryl acetate, is taught as a non-steroidal cosmetic soothing agent which is useful for treating inflammation of the skin (see column 44, lines 7-9 and 65), this reads on **instant claim 23**. McAtee also teaches the addition of thickeners (see column 29, lines 44-55), this reads on **instant claim 25**. The product of McAtee is taught as being flat, thick, circle, square, rectangular or oval pads (see column 15, lines 47-60), this reads on **instant claim 27**. McAtee further teaches that the lipid and aqueous phases can be added sequentially in any order (see column 50, lines 22-24), this reads on **instant claims 29-30**. The aqueous and lipid phases are taught as being applied by spraying methods (see column 55, lines 24-26), this reads on **instant claim 31**.

With regard to **instant claim 28**, McAtee teaches that the device taught can comprise more than two layers (see column 9, lines 26-28). Furthermore, it is well known in the art when marketing a single use hygiene device to package the device.

With regard to **instant claims 32-33**, McAtee teaches that when water is involved in the manufacturing process, that the composition is dried so that it is substantially free of water (see column 50, lines 65-67). McAtee further teaches that said drying process occurs by means of a convection oven, radiant heat source, microwave oven, forced air oven, or heat rollers or cans (see column 51, lines 3-5).

With regard to **instant claim 35**, McAtee teaches a method of cleansing and conditioning the skin or hair with the device of McAtee (see column 51, lines 14-17).

McAtee fails to directly disclose the instant percentages for the components.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to arrive at the amounts of the instant invention. One would have been motivated to do so since McAtee sets forth a clear percentage of the total amount of "lipid hardening materials", and teaches that mixtures of the components are useful. Specifically, while it would have been obvious to utilize equal amounts of the components being combined in the mixture of lipid hardening materials since McAtee teaches all of the components as being useful for the same purpose, it would further have been obvious to utilize a greater amount of triglycerides since triglycerides are taught as being representative of at least three of the groups taught (see column 32, lines 49-50, and column 33, lines 44-48 and 56-51). There would be a reasonable expectation of success in utilizing said components in equal amounts, with triglycerides



being present in a greater amount since McAtee teaches all of said components for the same purpose. It is noted that MPEP 2144.05 states: “It is *prima facie* obvious to combine two compositions each of which is taught by the prior art to be useful for the same purpose, in order to form a third composition to be used for the very same purpose.... [T]he idea of combining them flows logically from their having been individually taught in the prior art.” *In re Kerkhoven*, 626 F.2d 846, 850, 205 USPQ 1069, 1072 (CCPA 1980) (citations omitted). See also *In re Crockett*, 279 F.2d 274, 126 USPQ 186 (CCPA 1960); and *Ex parte Quadranti*, 25 USPQ2d 1071 (Bd. Pat. App. & Inter. 1992). It is further noted that MPEP 2144.05 states: “Generally, differences in concentration or temperature will not support the patentability of subject matter encompassed by the prior art unless there is evidence indicating such concentration or temperature is critical. “[W]here the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation.” *In re Aller*, 220 F.2d 454, 456, 105 USPQ 233, 235 (CCPA 1955).”

#### *Response to Arguments*

Applicant argues in the response filed 09/08/2009 that McAtee fails to anticipate or render obvious the instant invention. Applicant's arguments have been fully considered and are found partially persuasive. Applicant's argument that McAtee fails to *anticipate* the invention as currently presented in amended claim 1 is found persuasive. However, as set forth in the new grounds of rejection above, Applicant's argument that McAtee fails to render obvious the instant claims as currently amended is not found persuasive.

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thornton*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

**Claims 1, 3, 6, 7, 10-12, 14-16, 23, and 25-31 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 3, 6-8, 10-12, 14-17, 23-31 of copending Application No. 10/521,070. Although the conflicting claims are not identical, they are not patentably distinct from each other, particularly since copending claims 1, 3, 6-8, 10-12, 14-17, 23-31 are almost identical to instant claims 1, 3, 6-8, 10-12, 14-17, 23-31.**

Copending claim 1 and instant claim 1 have a slight variation in that instant claim 1 does not allow the product to be a porous or absorbent sheet. Both the copending claims and the instant claims teach that the product can be a puff, pad, sponge, cotton

ball, swab, brush, glove, mitt, or bar. Besides the slight variation in copending claim 1 and instant claim 1, the claim sets are identical. Copending claims 1, 3, 6-8, 10-12, 14-17, 23-31 render obvious instant claims 1, 3, 6, 7, 10-12, 14-16, 23, and 25-31 because the specified products taught by both claims are not porous or absorbent sheets, such as puffs, pads, sponges, cotton balls, swabs, brushes, mitts, or bars. Since both of the applications read on identical forms of product, the slight variation in instant claim 1 is insufficient to overcome a finding of obviousness. Furthermore, the copending claims are silent regarding porosity and absorbency, hence including porous and non-porous as well as absorbent and non-absorbent sheets. The instant claims are therefore rendered obvious by the above identified copending claims of '070, and therefore are rejection under obviousness-type double patenting.

#### *Response to Arguments*

Applicant argues in the response filed 09/08/2009 that since the copending claims have not been patented that the decision with regard to obviousness-type double patenting should be held in abeyance. Applicant's argument is not found persuasive. The rejection is maintained.

#### **Conclusion**

No claims allowed. All claims rejected. No claims objected.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to TREVOR M. LOVE whose telephone number is

(571)270-5259. The examiner can normally be reached on Monday-Thursday 7:30-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sharmila Landau can be reached on 571-272-0614. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

TL

/Gerald G Leffers Jr., PhD/  
Primary Examiner